



AF/3743  
123  
Docket No.: 2035.733  
Serial Number: 09/579,846

**THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Applicant: Richard Wisniewski Confirmation No.: 8512  
Serial No.: 09/579,846 Group Art Unit: 3743  
Filed: May 25, 2000 Examiner: John K. Ford  
Title: ENHANCED THAWING OF BIOPHARMACEUTICAL SOLUTIONS USING  
OSCILLATORY MOTION

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Date of Signature: October 14, 2004

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**REPLY TO EXAMINER'S ANSWER BEFORE THE BOARD OF PATENT  
APPEALS AND INTERFERENCES**

Dear Sir:

This is a reply under 37 CFR § 1.193 from an Examiner's Answer dated August 30, 2004. Therefore, this Reply Brief is timely filed within two months, i.e., by October 30, 2004.

## **ARGUMENTS**

This paper relates to the Grounds Of Rejection section of the Examiner's Answer, dated August 30, 2004, which is incorporated herein by reference. The points raised in the Examiners Answer are addressed below.

### **1. 35 U.S.C. § 112 Rejections:**

The Examiner continues to object to claim 18 as not complying with the written description requirement under 35 U.S.C. § 112 because the Examiner alleges that applicant was not in possession of the subject matter of the claims at the time of filing of the application. Specifically, the Examiner continues to allege that the container recited in claim 18 could not roll, but instead wheels or other means in contact with a surface upon which the container moves must roll. Applicant respectfully disagrees with the Examiner as further described below.

The Examiner objects to applicant's use of "roll" to refer to a container rolling as recited in claim 18, because it is alleged that one could also say that a car is "rolled" or that it "rolls-over" and that such variations along with applicants' description of a car rolling are colloquial expressions which invalidate the use of "rolls" in claim 1 as not satisfying the written description requirement. The Examiner's argument is flawed, however, because a car, like applicant's invention, may roll on wheels. Thus, applicant respectfully disagrees with the Examiner's assertion that a car does not "roll" from place to place and that instead a car must be "driven from place to place". In fact, a car may "roll" to a stop even if the wheels also roll, for example. Thus, the different expressions cited by the Answer do not change the fact that a vehicle may "roll" or that a container may "roll" without one specifically referring to such a vehicle or container as having wheels which do the "rolling."

Also, as noted previously, the specification describes a "wheeled container" on page 5, and depicts a container having wheels in FIG. 1, but does not refer to a container being connected to intermediate elements and then wheels. Instead, the "wheeled container" signifies to a reader that the wheels may be part of the container. Further, the claim itself recites that the container "rolls". Thus, the use of the word "container" and the word "rolls" read in light of the specification would indicate to one skilled in the art that the container may be a "wheeled

container” as described on page 5 and depicted in FIG. 1, which may “roll”.

As described on page 7 and depicted in FIGS. 9A-9B, a container moves along a track. There is no description in the specification of wheels of the container moving along the track or other such intervening elements although such wheels are depicted. Instead, the wheels or other means for allowing such motion are understood to be part of the container which is described as moving along the track. Further, as described on page 9 and depicted in FIG. 10A, a container is driven by a driver. Thus, the specification describes a container being moved along a track and a container being driven without any description of wheel portions of these containers allowing such movement. Applicant recognizes that the embodiments in FIGS. 9A-B and 10A were not elected in response to the Restriction Requirement, but the descriptions of these containers moving without explicit reference to wheels or other intervening elements further support the proposition that it is not necessary to explicitly describe that wheels of a container roll or allow movement of such a container along a surface.

The Examiner also notes that applicant did not emphasize the first dictionary definition which was enclosed with the Appeal Brief. As indicated by the Answer, applicant included a dictionary entry having several different definitions, and emphasized the one which was most appropriate given the specification. There is no requirement that a claim rely on the first listed dictionary definition in a dictionary entry. In particular, the selected entry defines “roll” as “to move on rollers or wheels” which is the most appropriate given the depiction in FIG. 1 of a container having wheels and a description on page 5 of a “wheeled container”. The mere use of the word “roll” implies the use of intervening elements such as wheels or rollers which are described on page 5 of the specification and depicted in FIG. 1, and which the Examiner has expressed as being necessary to make it clear to one skilled in the art what is occurring in this claim.

Further, the Answer alleges that applicant failed to explain how the container can roll along, and be in contact with, a surface, and at the same time have “wheels or other means” separating the container from the surface. As noted above, page 5 of the specification, FIG. 1, FIGS. 9A-D, and FIG. 10 disclose a container having wheels. Therefore, a portion of the container (i.e., the wheels) rolls on the surface.

Thus, the expression that a vehicle “rolls” referred to in the Appeal Brief and the dictionary definition referred to by applicant imply the use of the intervening elements which the Examiner has stated as being necessary to make the term “roll” clear to one of ordinary skill in the art. This inference is strengthened by the specification description of a “wheeled container” on page 5 of the specification and the depiction in FIG. 1 of a container having wheels. A reader of claim 1 in light of the specification would thus understand that the container recited in claim 1 may be a “wheeled container”. Accordingly, one skilled in the art would understand the container recited in claim 18 may “roll”.

Moreover, applicant respectfully disagrees with the Examiner’s assertion that the container cannot “roll” along a surface. In particular, the container recited in claim 18 may “roll,” because it may have wheels as depicted in the figures and described on page 5, the dictionary definition cited defines “roll” as “to move on rollers or wheels”, and because the word “roll” is commonly used to refer to the movement of an object on wheels or rollers without explicitly referring to such wheels or rollers. Therefore, it is respectfully submitted that one of ordinary skill in the art at the time the application was filed would understand that the applicant had possession of a container having wheels. Accordingly, because § 112, first paragraph, merely requires that the subject matter of the claimed invention be described in the specification, it is respectfully submitted that this rejection is overcome.

#### **Prior Art Rejections:**

The Answer has continued to reject the independent claims over the combination of a tank in combination with a shaker table as described in the cited references. As described on page 11 of the Answer, a container or tank would be fixed or maintained stationary relative to a surface of a shaker table upon which it was located. The shaker table itself may move or even roll upon certain rollers or wheels. However, the container itself would not roll or move along, and in contact with, a surface as recited in claims 18-21. Instead, the container may move with the shaker table as the shaker table moves, but it would not move relative to the shaker table and would not move along, and in contact with, the top surface of the shaker table, nor any other surface.

The Answer describes various situations in which a shaker table may be considered to

roll and alleges that a container on top of the shaker table would also roll. However, there is no allegation in the Answer that a container would move along, and in contact with, a surface. Instead, the Answer appears to assume that the container would remain stationary relative to the shaker table and would move as the shaker table moves. Such movement of the shaker table would not provide movement of the container along, and in contact with, a surface. Even if the shaker table did roll on rollers or wheels, the container itself is in contact with a top surface of the shaker table and would not roll or move along, and in contact with, the top surface of the shaker table, but instead the bottom surface of the shaker table would roll or move on rollers or wheels. Further, even if the container was considered to roll or move as a result of rolling or moving of shaker table on which it was located, the container would not move along, and in contact with, the shaker table, or any other surface. Instead, the container would be in contact with the top surface of the shaker table, but the container would not move along the top surface of the shaker table. Therefore, the references cited by the Examiner cannot make obvious claims 18-21 of the present application. The individual references and the comments of the Examiner relative thereto are addressed below.

**Wisniewski and Wu in View of DE 3047784 and JP 63-246,831:**

The Examiner's Answer continues to reject the claims in question as being obvious over the Wisniewski and Wu article in view of various other references. The Answer first asserts that if one were to consider Wisniewski and Wu in view of German reference DE 3047784, a container placed on a shaker table would roll on rollers back and forth along with the top of the shaker table. The container would allegedly roll back and forth on rollers of the shaker table depending on various mechanical portions thereof. However, it is respectfully submitted that the container recited in claim 18 rolls along, and in contact with, a surface. Any container placed on the shaker table described in the Answer would not roll. The shaker table platform may roll, and the container may move as the shaker platform moves, but the container described does not include wheels or rollers or any other means for rolling and thus would not roll. As described above, the specification of the present application discloses several embodiments of a container having wheels. The container described in the specification and recited in the claims therefore may roll due to the inclusion of such wheels. In contrast, the Examiner alleges that a container could "roll" on rollers of shaker table which are separated from the container by the shaker table

itself. Such a container may move and the platform may roll, but the container would not roll due to the lack of implements for rolling. In contrast, as described above, page 5, page 9, FIGS. 1, 9A-9D, and 10A describe and depict a container having wheels. Of course, these are exemplary embodiments and the container recited in claim 18 may roll on rollers or other means which are integral to the container.

Even if the container described in the Answer relative to DE 3047784 was considered to roll on rollers back and forth along with a top of a shaker table as alleged in the Answer, the container located thereon would not roll along, and in contact with, the surface of the shaker table. In particular, the phrase “along with” in the formulation of “back and forth along with the top of the shaker table” as formulated by the Examiner changes the meaning such that it is different than the phrase recited in claim 18. The phrase “along with” negates the movement of container from one position to a different position on the top of the shaker table, and instead the container would travel along with the platform and would be stationary relative thereto. Such distinction is further noted by the recitation in this claim of rolling the container from a first position to a second position along, and in contact with, the surface, and rolling a distance from the second position toward the first position along, and in contact with, the surface. Thus, the use of “along with” by the Examiner causes the meaning to change such that the container is stationary relative to the surface of a shaker table, and such container does not move along the surface of the table, nor does it move in contact with the surface or from a first position to a second position and from the second position toward the first position.

The Examiner also refers to Ref. '831, and in particular alleges that if the tank of Wisniewski and Wu was placed on the shaker table of Ref. '831, “the container ... would be moved or rolled (via rollers 19) between a first position and a second position ... along a surface.” However, notwithstanding that a container on a shaker table would not “roll” as described above, the Answer omits describing the container as moving in contact with, the surface. Further, it is unclear how this container could move “along” a surface without moving relative to such surface. In particular, the container would be stationary relative to the shaker table upon which it rested and would not move along the table. As depicted in FIGS. 2-4 of this reference, a shaker table has wheels 17 which allow a shaker tabletop 13 to move back and forth. The moving in this reference is performed by the shaker table top with the container remaining

stationary on top thereof, but even if the container was considered to roll due to any rolling of the table top, the container would not be considered to roll along, and in contact with, the surface. In particular, the container sits on the table top but does not sit on the surface on which wheels 17 of the shaker table system roll, i.e., a container utilized in the device of Ref. '831 does not move or roll along, and in contact with, the surface on which the wheels of the shaker table roll.

Further, although the Examiner argues that the container recited in claim 18 rolls upon separate elements not mentioned (e.g., wheels thereof), these elements are a part of the container as noted by the specification describing the container as being a "wheeled container," the depictions of the container having wheels in the figures, and the descriptions of the container moving along the track and being driven described above relative to the § 112 rejection. In contrast, the wheels depicted in Ref. '831 are part of the shaker table not the container, and the container could not be considered to roll along, and in contact with, a surface which it does not contact and upon which the wheels of the shaker table roll.

Accordingly, because neither Wisniewski and Wu, Ref. DE 3047784, nor JP 63-246,831, nor their combination, disclose, teach, or suggest a container which rolls or moves along, and in contact with, a surface, nor such a container rolling from a first position to a second position and from the second position toward the first position, along, and in contact with, the surface, the alleged combination cannot make claim 18 of the present application obvious.

Regarding claims 19-21, the alleged combination does not disclose, teach, or suggest movement of a container from a first position to a second position and from the second position toward the first position, along, and in contact with, a surface. Further, there is no disclosure of such a first position and second position being separated from each other by a distance along the surface. Moreover, relating to claim 20, there is no disclosure of such a container being moved in such a manner by a motor driving a linkage. Accordingly, independent claims 19-21 are believed not to be obvious and are believed to be allowable.

**Wisniewski and Wu in View of Japanese Reference JP 2-187138:**

The Examiner argues in the Answer that applicant's use of the word "roll" is inconsistent relative to Ref. '138 and the § 112 issues described above. Applicant respectfully disagrees and

reasserts that the combination of Wisniewski and Wu and Ref. '138 would not disclose, suggest, or teach a container which rolls or moves along, and in contact with, a surface.

The Examiner's Answer refers to Applicant's assertions on page 12 of the Appeal Brief, which indicates that a platform in Ref. '138 rolls instead of the container rolling. In particular, the Examiner alleges that Applicant is inconsistent by arguing that the container recited in claim 18 may "roll" without specifying that the wheels thereof are doing the rolling on the surface while simultaneously arguing that the container if it were to be placed on the platform of Ref. '138 would be stationary relative to the platform on which it sits, and would not roll on the wheels or rollers which the platform itself is rolling. As noted above, the container recited in claim 18, described in the specification, and depicted in the figures, may include wheels for rolling. These wheels are part of the container as indicated by the language cited in the specification, while the wheels or rollers of the platform are obviously not part of the container. Thus, the platform of the shaker table may roll on rollers on a bottom surface thereof, but a container as described by the Answer which does not include wheels could not roll. In contrast, the specification of the present application supports a container which rolls.

Further, as described in the last sentence on page 9 of the Examiner's Answer, the movement of the container on the platform of a shaker table would be "with a surface", i.e., the platform. Thus, even if the container was considered to roll on the rollers of the shaker table of Ref. '138, the container would roll with the platform on the rollers, and would not roll or move along, and in contact with, the platform upon which it would be located. The container would therefore not move along, and in contact with, a surface.

**Wisniewski and Wu in View of Japanese Reference JP 2-261371:**

The Examiner alleges relative to this reference, similar to the previous references, that the rolling of platform of a shaker table on support bars is equivalent to a container moving along, and in contact with, a surface. Further, the Examiner notes that a container could be fixed relative to the shaker table with any means of anchoring the container. Claim 18, recites, inter alia, a container moving from a first position to a second position along, and in contact with, a surface, and the container rolling a distance from the second position toward the first position along and in contact with, the surface. A container fixed relative to a platform of a



shaker table could not move along, and in contact with, the platform of the shaker table, nor could it move from a first position to a second position, and a distance from the second position toward the first position. The platform in Ref. '371 may roll, but a container thereon does not roll along, and in contact with, a surface.

Further, applicant respectfully submits that there is no contradiction in asserting that a container rolls without including the details that wheels thereof roll, while agreeing that a platform may roll on rollers or other means. As described above, the use of the word "roll" in conjunction with the specification and drawings of the present application make clear that the container described therein would include any wheels or rollers necessary to allow rolling thereof. Further, as recited in claim 18, a container may roll along, and in contact with, a surface, but this is not the same as a container being fixed to a platform which rolls. In the latter case, the container is not moving along, and in contact with, the surface upon which it sits, and instead the container moves with the platform as asserted by the Examiner, but the container is fixed and does not roll along, and in contact with, the surface upon which it is located.

Moreover, as noted in the Answer, applicant previously asserted that if a container did move along, and in contact with a surface of such a platform, it would be thrown from such platform. The Examiner's Answer countered that such a platform would typically utilize means for anchoring the container. As noted above, such anchoring would prevent movement along, and in contact with, the surface. Applicant respectfully reasserts that any movement of an unanchored container along, and in contact, with the surface upon which it is located (i.e., the platform) would cause such container to be thrown from the platform therefore making the platform unsatisfactory for its intended purpose. Even if the container was unanchored and it was not thrown from the platform for some reason, there is no reason to believe that it would move from a first position to a second position and a distance from the second position toward the first position along, and in contact with, a surface as recited in claim 18.

Therefore, because the alleged combination does not teach, disclose, or suggest the features (e.g., a container which moves along, and in contact with, a surface from a first position to a second position and which moves from the second position toward the first position, along, and in contact with, the surface) recited in claim 18, this claim is believed not to be obvious over such combination. Claims 19-21 are also believed not to be obvious for the same reasons and for

their own additional features. For example, the arguments described above relating to rolling along, and in contact with, a surface are applicable to the movement recited in claims 19-21, excluding the remarks relating specifically to "rolling" as the form of movement. Further, as noted above there is no disclosure, teaching, or suggestion of movement from a first position to a second position along, and in contact with, a surface using a motor driving a linkage.

### **CONCLUSION**

In conclusion, Appellant submits that claims 2, 3, 6 and 9, 18-21 are supported by the specification and are not improper under 35 U.S.C. § 112, first paragraph. Further it is respectfully submitted that claims 2, 9, and 18-21 are not obvious over the 1992 Wisniewski and Wu article in view of German Reference No. DE 3047784, Japanese Reference No. 63-296,831, Japanese Reference No. 2-187,138 or Japanese Reference No. 2-261,371. Therefore, Appellant submits that the Final Office Action should be reversed in all respects.

Respectfully submitted,



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Dated: October 14, 2004

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In Re Application Of: Wisniewski

Application No.	Filing Date	Examiner	Customer No.	Group Art Unit	Confirmation No.
09/579,846	05/25/2000	John K. Ford	23405	3743	8512

Title: **ENHANCED THAWING OF BIOPHARMACEUTICAL SOLUTIONS USING OSCILLATORY MOTION**



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